

## Remarks

- 1) Applicant thanks the Examiner for his well considered office action and hopes that this response will further the understanding of applicant's invention.
- 5 Applicant further thanks the Examiner for the personal interview conducted in the PTO on April 28, 2004. As the Examiner and applicant's representative agreed, it is not necessary for applicant to provide a separate record of the substance of the interview (see Examiner interview summary).
- 10 2) Claims 73-134 are pending in the application. Applicant amended claims 73, 76, 88, 90, 101, 116, 120, 123, 125, and 127. Claim 122 was cancelled without prejudice.
- 15 3) Applicant thanks the Examiner for agreeing with the characterization of the Krisbergh (US 5,999,970, or Krisbergh '970 hereinafter) reference as directed to an access system, but applicant again draws the Examiner's attention to the claimed limitation of e.g. claim 73 and others, that clearly require the generating<sup>\*</sup> a video signal corresponding to the message. ("video output module for generating video signals corresponding to said message.") As was shown before, Krisbergh '970 does not teach the conversion of the signal to a video message and the main thrust of the Krisbergh reference is directed to an access system, that transfers data via the vertical blank interval. While the data may be email data, the content of the data is incidental to the access system, and that no video signal is generated. Furthermore, Krisbergh '970 merely mentions the use of the access system for transmitting e-mail messages and as any transmission medium may be used to transfer e-mail messages, Krisbergh '970 does not enable a messaging system, especially one having the generation of video signals as claimed, and by teaching sending the data as such, actually teaches away therefrom. For those reasons, applicant submits that Krisbergh '970 is directed to a different field of art than the present application, teaches away from the present invention, and does not disclose all the elements claimed in
- 20 25 30 amended claim 73. Therefore it does not anticipate the present invention, and can not otherwise be properly combined to produce the present invention.

- 4) However, as there seem to be continued misunderstanding of the term 'video signals' as used herein, applicant amended the appropriate claims to include 'video frames'. Frames being a common term to describe visual information content, as opposed to mere transmission of message to the subscriber premises as data. The term "video frames" should be construed as the creation at the central location, of the message information in terms of visual frame data, from other data formats such as text data, image data, sound data, e-mail data, and the like. The video frame data is then encoded and sent to the subscriber premises. By way of example, the message information is converted into a format such as MPEG, or analog video format or equivalents of such formats, that are commonly used for transmitting video information in a television distribution system. Such video frame signal may be transmitted as digital television system signals, or as analog television signals, using such compression methods as MPEG or JPEG or similar digital television standards.
- 5 (It should however be noted that certain compression methods such as MPEG provide for sending a portion of a full video frame, and the term "video frame signals" as used herein extend to such sub frames, or to partial frames.)
- 10 Similarly, in the case of unified messaging, the term "video frame" encompasses streaming video, images, voice, and the like, all transmitted commonly as part of the video signal.
- 15
- 20
- 25
- 30
- 5) The Examiner rejected claims 120,121, 123, 125, 126, and 132-134 under 35 USC §102(e) over Kruger (U.S. Pat# 6,460,075), and further rejected claims 122, 124, 127 &128 as unpatentable under 35 USC §103(a) over Kruger and several official notices. Applicant respectfully points out that Krugger relate to a browser based thin client e-mail system located at the user premises (e.g. abstract, fig.1) that receives http format data from a network like telephone or ISDN, rather than receiving a video frame signal over a television network.
- 6) Applicant amended claim 120 to add the limitations that the step of recording be made via a telephone in a television messaging gateway located remotely to the user premises. Applicant submits that as Kruger does not discuss a television messaging gateway, and especially not one remote to the user premises, and as the use of a telephone to contact such a television messaging gateway to record such message is neither disclosed nor hinted to in any of the other cited

references, the claim as amended is novel and unobvious. Claim 121 is therefore similarly allowable. Claim 122 is cancelled without prejudice as its limitations were incorporated into claim 120, and further expanded upon.

- 7) Regarding the rejection of claim 123, the Examiner asserted that Kruger relates to a unified messaging system since Kruger handles multi-media e-mail messages. Applicant respectfully disagrees as the term unified messaging has no well defined meaning in the relevant industry, but has been defined in the specifications (page 2, ll. 4-9) to combine many types of messages including by way of example voice mail and faxes, as well as e-mail messages. E-mail messages alone, even if containing multi-media data, do not rise to the level of unified messaging, or replace voice or fax messages. As Kruger relate to implementing a thin browser, it is directed by nature to e-mails and hypertext messages, and is silent about faxes or voice mail messages. In order to further clarify the nature of the unified messaging system, applicant amended the claim to include at least one of the messages selected from the unified messaging system be selected from this type of messages, in accordance with the specifications text. Additionally, as explained above, the claim was amended to more clearly identify the format of the signals received as video frame format. Applicant submits that in light of the clarifications made herein and in the claim language, the claim is allowable and so is its dependent claim 124.
- 8) Regarding claim 125, the applicant amended the claim to clarify the video frame nature of the signal transmitted from the television messaging server. Applicant respectfully submits that as neither Krugger nor any other of the references discloses transmitting the message in video frame format, the claim, and its dependent claims are also allowable.
- 9) Applicant respectfully directs the Examiner's attention to *In re Lee*, 277 F.3d 1338, 61USPQ2d 1430, (Fed. Cir.) the court stated: "*The conclusion of obviousness may be made from common knowledge and common sense of a person of ordinary skill in the art without any specific hint or suggestion in a particular reference.*" The court remanded and stated answered "*THE FACTUAL INQUIRY WHETHER TO COMBINE REFERENCES MUST BE THOROUGH AND SEARCHING.*" *Id.* *IT MUST BE BASED ON OBJECTIVE EVIDENCE OF RECORD.*" and further "*("OUR CASE LAW MAKES CLEAR THAT THE*

*BEST DEFENSE AGAINST THE SUBTLE BUT POWERFUL ATTRACTION OF  
A HINDSIGHT-BASED OBVIOUSNESS ANALYSIS IS RIGOROUS  
APPLICATION OF THE REQUIREMENT FOR A SHOWING OF THE  
TEACHING OR MOTIVATION TO COMBINE PRIOR ART REFERENCES.");*  
5 quoting *In re Dance*, 160 F.3d 1339, 1343, 48 USPQ2d 1635, 1637 (Fed. Cir. 1998), and further quoting *In re Kotzab*, 217 F.3d 1365, 1371, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000) ("*PARTICULAR FINDINGS MUST BE MADE AS TO THE REASON THE SKILLED ARTISAN, WITH NO KNOWLEDGE OF THE CLAIMED INVENTION, WOULD HAVE SELECTED THESE COMPONENTS FOR COMBINATION IN THE MANNER CLAIMED*");  
10 and more specifically, *In re Rouffet*, 149 F.3d 1350, 1359, 47 USPQ2d 1453, 1459 (Fed. Cir. 1998) ("*EVEN WHEN THE LEVEL OF SKILL IN THE ART IS HIGH, THE BOARD MUST IDENTIFY SPECIFICALLY THE PRINCIPLE, KNOWN TO ONE OF ORDINARY SKILL, THAT SUGGESTS THE CLAIMED COMBINATION. IN OTHER WORDS, THE BOARD MUST EXPLAIN THE REASONS ONE OF ORDINARY SKILL IN THE ART WOULD HAVE BEEN MOTIVATED TO SELECT THE REFERENCES AND TO COMBINE THEM TO RENDER THE CLAIMED INVENTION OBVIOUS.*")

15 Furthermore, the mere fact that the claimed invention is within the capabilities of one skilled in the art is not sufficient to establish obviousness (see MPEP 2143.01) "*RARELY, HOWEVER, WILL THE SKILL IN THE ART COMPONENT OPERATE TO SUPPLY MISSING KNOWLEDGE OR PRIOR ART TO REACH AN OBVIOUSNESS JUDGMENT.*" (*Al-Site Corp v. VSI Int'l Inc.*, 174 F.3d 1308, 50 USPQ2d 1161 (Fed. Cir. 1999). (Emphasis added))

20 10) Regarding claims 122, 124, and 127-128, the Patent Office took an official notice of the fact that using a telephone to send a message, uploading video and audio was known, and that message receipt notification are all known in the art, and therefore rejected the claims under 35 USC 103(a) as being obvious over Kruger.  
25 Applicant respectfully submits that the Office did not establish how any of the above is known in the appropriate context, nor did the Examiner point to any objective evidence of record or particular findings as to the reason the skilled

artisan would have selected to combine the specific elements without hindsight impermissibly provided by the present invention. Furthermore, the Examiner did not provide a reason why the skill in the art component should operate to supply the missing knowledge in Krugger to reach the obviousness judgment. Applicant  
5 also points out with regards to claim 127 that the use of a telephone implies recording at a television messaging gateway or messaging server remote from the user premises. Additionally, regarding claim 124, applicant points out that the claim limitations require RECORDING to be carried out by a server remote from the television, i.e. remotely from the subscriber premises. Recording  
10 remotely is markedly different from uploading audio or video data from a subscriber.

11) The Office rejected claims 73-74, 77-83, 85-90, 92, 101-102, 106, 111, 113, 116&119 as being unpatentable over Krisbergh '970 in view of Born, (US 6,064,440). Applicant respectfully disagrees.

15 12) Regarding claim 73, the Krisbergh 970' reference was discussed in detail in a response to a previous office action, and was clearly differentiated from the present invention as it merely discloses an access system and thus is not enabling or teaching even remotely of the present system, and as the information is transmitted as data superimposed on the video blanking intervals, rather than as a video signal. The examiner contends that Born discloses the transmission of numerous types of services over a CATV system, using the well-known VBI technology, but that Born also discloses that in order to achieve a higher data throughput the CATV operator may use the regular lines of video to transmit data services instead of only the VBI. Applicant agrees with  
20 this characterization, but submits that the Born patent clearly relates to the transmission of DATA over a video signal, rather than a frame video signal, i.e. a video signal representing an image. (abstract, col. 2 ll. 64-67, col. 3, ll. 38-49) The data is extracted from the selected video lines by a receiver, i.e. the set top box at the subscriber premises (col. 3, ll. 68-67, col. 5, ll. 51-55). Set top box  
25 converter 234 "... extracts the requested data and recovers the bitmap. Based upon the received bitmap, set-top converter 234 drives the television screen 236a so as to display the selected website." It is clearly seen therefore, that the conversion of the message DATA, into a video frame signal occurs at the set-

top box, rather than at the television messaging gateway as claimed in claim 73 and its dependent claims.

However in light of the apparent continued misunderstanding as to the exact nature of the originally claimed 'video signal', applicant amended claim 73 to read 5 'video FRAME signal' in order to better clarify the video frame oriented nature of the signal generated by the video output module in the television messaging gateway.

Applicant would like to stress that the method of transmission, encoding, or modulation of the video frame signal is immaterial. Further, as messages may 10 be divided into several frames, ( for example in the case of multiple message pages, zoom requirements, or other messages that do not conveniently fit within a single video frame), a single frame may also display just a portion of such message.

In light of the above comments and amendment, applicant submits that none of 15 the disclosed references disclose the required limitation of generating a video frame signal corresponding to the message, at the television messaging gateway in the central location. Therefore applicant requests that the rejection of claim 73 and all its dependent claims be reconsidered and withdrawn.

13) Regarding claim 81, in addition to the already shown non-obviousness of claim 20 73, applicant respectfully directs the Examiner's attention to the requirement of *in re Lee*, and requests that the Examiner will show the objective evidence of record, and the particular findings why the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed, as required by *In re Rouffet*. Applicant submits that the mere fact that speech recognition technology was known, is insufficient to show 25 motivation to combine such technology with television messaging environment, or with controlling a messaging gateway.

14) Regarding claim 82, in addition to the motivation required to combine as was 30 detailed regarding claim 81 and elsewhere, and the already shown non-obviousness of claim 73, applicant submits that none of the references discloses or hints about having the terminal (e.g. set top box) capture the user input voice and transfer that voice input to the remote input device interface, and furthermore that at least one of the cited references specifically teaches away

from it. Kruger teaches specifically that the local browser records and process and compress the input voice (col. 5, ll. 55- col. 6 ll. 15), all of which requires very significant processing power by the local terminal. Conversely, the relatively simple act of capturing the user voice and transmitting it (by analog or digital means) to a remote site for processing, provides significant advantages to this aspect of the invention, as the required processing, such as for example digitizing, compressing and/or voice recognition, is centralized which offers cost savings, ease of maintenance and other advantages. Therefore, applicant submits that Office did not met the criteria required for a *prima facie* obviousness, and the rejection should be withdrawn.

- 5
- 10
- 15
- 20
- 25
- 30
- 15) Regarding claim 86, besides being unobvious in light of the showing made regarding claim 73, applicant points out that Krisbergh '970 does not allow the user to identify and select the terminal to directs messages to. The Krisbergh patent directs the messages to the specific terminal from the user signals were received. On the other hand, an embodiment of the present invention equipped with the feature claimed in claim 86 will allow directing the messages to another terminal, thus if for example the user utilizes a telephone network to connect to the television messaging gateway from a location different than his usual premises (e.g. a neighbor house), the system can direct messages to a set-top box at that location, responsive to the user implicit signals or by utilizing a caller ID, and the like. (See present application, e.g. page 12, ll. 3-13.)
  - 16) While applicant maintain that claim 88 is allowable as is in view of the showing made for claim 73, applicant amended the claim in order to more specifically direct it to but one of the preferred embodiments, in which the system is adapted to handle unified messaging, i.e. handling at least one of message types stated in the claim. Applicant maintains off course his claim to text messages and multi media messages as applicable to the rest of the claims, as they were shown allowable for non related reasons.
  - 17) Regarding claim 90, applicant disagrees with the Office assertion that Krisbergh transmits digital video signals. Applicant carefully examined the Krisbergh '970 patent and failed to find any reference to digital video. Moreover, applicant points out that digital video makes the use of data transmission over VBI completely redundant, as in digital television the data, audio, and video frame

signals are all transmitted digitally, mostly in encoded form such as MPEG2, and synchronization signals such as the vertical and horizontal blanking interval signals are generated as needed in the decoder, i.e. set-top box or similar terminal. Therefore the operating principle of digital video signals are incompatible with the Krisbergh '970 operating principle of using the VBI.

5

18) Regarding claim 101, applicant amended the claim to again better claim the frame nature of the video signals generated at the central location. Applicant respectfully submits that the claim as amended, and its depended claims, are allowable in view of the showing made above with regard to claim 73.

10

19) Regarding claim 113, applicant submits that as the showing made regarding claim 123 made clear, none of the references was shown to relate to handling and delivery of unified messaging. In light of this and explanation relating to other claims, applicant respectfully submits that the claim is allowable.

15

20) Claims 75 and 117 stand rejected as unpatentable over Krisbergh '970 & Born, in view of Krisbergh (U.S.# 5,138,649, hereinafter Krisbergh '649). The office asserted that Krisbergh '649 relates to a combination of telephone handset and to a television remote control. However Krisbergh '649 does not relate to messaging systems, to controlling a television messaging gateway, and clearly not to controlling a television messaging gateway remote to the television controlled by Krisbergh '649. Neither Krisbergh 970 nor Born, suggest controlling a television messaging gateway using a telephone keypad. Therefore, applicant respectfully submits that the office did not meet the requirements of showing of prima facie obviousness, see *in re Lee*, *in re Kotzab*, *in re Rouffet* and MPEP 2143.01. In addition to being allowable in view of the showing made for their independent claims, applicant submits that for the reason presented above the claims are allowable. Similarly claims 84 and 105 are also allowable.

25

21) Claims 76, 91, 103-104, 114-115 & 118 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Krisbergh '970 & Born in view of Kruger.

30

22) Regarding claim 76, the Examiner asserted that Kruger relates to a unified messaging system since Kruger handles multi-media e-mail messages. Applicant respectfully disagrees as the term unified messaging has been defined in the specifications (page 2, II. 4-9) to combine many types of messages

including by way of example voice mail and faxes, as well as e-mail messages. E-mail messages alone, even if containing multi-media data, do not rise to the level of unified messaging, or replace voice or fax messages. As Kruger relate to implementing a thin browser, it is directed by nature to e-mails and hypertext messages, and is silent about faxes or voice mail messages. In order to further clarify the nature of the unified messaging system, applicant amended the claim to demand at least one of the messages selected from the unified messaging system be selected from this type of messages, as discussed in the text.

5 Applicant submits that in light of the clarifications made herein and in the claim language.

10

23) Regarding claim 91, applicant submits that in light of the amendment made to claim 73, and the showing supplied therefore, the claim is allowable. Similarly, claim 103-104 are allowable in light of the amendment and showing presented regarding claim 101. Further similarly, regarding claim 114-115 & 118, applicant submits that the claims are allowable in light of the showing made regarding claim 113, and further in light of the demands of in re lee, in re Kotzab, in re Rouffet, and ai-site corp., that claim 115 is further separately allowable.

15

24) Applicant has made a good faith effort to address each and every point made by the Examiner, and amended the claim and the specifications in order to place the application in condition for allowance. Should the Examiner find any deficiency in this amendment or in the application, or should the Examiner believe for any reason, that a conversation with applicant's agent may further the allowance and issuance of this application, the Examiner is kindly requested to contact Shalom Wertsberger at telephone (207) 799-9733.

20

25 In light of the amendments, showing and all other reasons stated above, applicant believes that rejections presented by the Examiner in the office action mailed to applicant December 4<sup>th</sup>, 2003 were overcome. Applicant therefore submits that the claims as amended are in condition for allowance. Reconsideration and withdrawal of the rejection and issue of notice of allowance on all pending claims is respectfully solicited.

30

Respectfully submitted



Shalom W.

Shalom Wertsberger

Reg. Num 43,359

30 Fern Lane

South Portland, ME 04106

Phone: (207) 799-9733

Fax: (207) 767-5324

Agent for Applicant

5